

REMARKS

Pending are claims 56-66 and 68-81.

Claim Rejections - 35 U.S.C. § 103

The Examiner continues to reject dependent claims and thus provides piecemeal prosecution of the present invention. The four different obviousness rejections other than the first rejection of the main claim, claim 56 seems redundant. Applicant respectfully submits that claim 56 having the limitations of former claim 67 and those claims ultimately dependent on claim 56 are patentable and unobvious over the prior art.

Thus, the rejections of the dependent claims by adding more references to the main references cited against claim 56 are respectfully inappropriate and should be withdrawn for reasons already of record in the prosecution of the present application. There is no need to continually repeat the arguments already presented.

Reconsideration is respectfully requested of the rejection of claims 56-66 and 79-81 under 35 U.S.C. §103 as allegedly unpatentable over Sugawara and Tetenbaum and in view of U.S. 5,073,442 to Knowlton *et al.*, U.S. 3,632,419 to Horie *et al.*, and U.S. 5,770,656 to Pechhold.

Sugawara describes a textile finishing composition comprising a urethane made by reacting a polyisocyanate with a polyfunctional compound. Such polyfunctional compound may be a polyether polyol. Sugawara notes at col. 3, lines 57-61 that other materials can be added to the composition without particularly pointing out the specifics of these materials. These include the mere mention of a stain-preventing agent.

With respect to the claimed invention, Sugawara fails to teach the HLB value range and the presence of a long chain alcohol. There is no assurance that the Sugawara urethanes would meet the HLB values claimed herein. More importantly, applicants have provided data in the specification showing that the range of 1-11 for HLB provides superior results than compositions having 0 HLB and those with higher than 11 HLB. See Table 4 and discussion on pages 24 and

25 of the specification. Sugawara also fails to teach two aspects of the present invention, particular stain blocking agents recited in the main claim and the presence of a long chain alcohol. Furthermore, it is noted that the finishing compositions of Sugawara are for shrinkage resistance, crease resistance, resilience and bulkiness to textiles. (Col. 1) The emphasis of the Sugawara teaching is not on soil resistance.

To fill the gap of the Sugawara reference, Examiner cited Tetenbaum. Tetenbaum discloses a water dispersible modified polyurethane which may contain a long chain alcohol as a capping agent. In the present invention, the long chain alcohol is not used as a capping agent. The capping agent is to prevent the polymer from getting too long and becoming water insoluble. (Col. 8, lines 50-52). In contrast, the use of a long chain alcohol in the present invention is used for providing performance of the composition by imparting water repellency and some anti-soiling properties to the polymer. It is particular noted that the use of the Tetenbaum compositions are for a different purpose than the present invention. Tetenbaum's compositions provide superior efficiency in thickening aqueous compositions. See the abstract in Col. 3, line 9. Since the Tetenbaum composition has different properties for a different purpose, it does not teach the use of stain blockers as claimed herein. Since the compositions are used to impart water repellency and anti-soiling, the long chain alcohol provides additional advantages which need not be recited in the claim as functional language, which the Examiner has appeared to suggest. A composition and its properties must be viewed as a whole.

In order to fill the still remaining gap between the prior art and the present invention as claimed, the Examiner has provided additional references, the patents to Knowlton *et al*, Horie *et al*., and Pechhold. Each of these individual patents disclose either soil or stain blocking agents. However, none of the three references suggest that these stain blocking agents may be used in conjunction with a urethane. The stain resistant agents described in Knowlton *et al*. are applied to a polyamide fiber. The soil resistance agents described in Horie are also applied onto polyamide or polyester fabrics. Pechhold provides fluoroesters or thioesters as stain blocking agents, again applied onto fibers. Neither of the three references address particularly the combination of these

agents with a urethane to provide a finishing composition as claimed. Thus, one skilled in the art would not find any suggestion from these references to use stain blocking agents with a urethane.

The present rejection has employed five references for which there is no suggestion or motivation to combine. None of the references, Tetenbaum or the additional three references showing stain blocking agents would motivate one skilled in the art to combine them with the Sugawara patent. "When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination." *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc.*, 30 USPQ2d 1377 at 1379-80 (Fed. Cir. 1994) and citing *In re Geiger*, 2 USPQ2d 1276, 1278. The Federal Circuit also stated in citing *In re Oetiker*, 24 USPQ2d 1443, 1446 that "the motivation to combine references cannot come from the invention itself." It is respectfully submitted that the Examiner has applied the invention itself to reject the claims by picking and choosing elements from a combination of five references. "The knowledge that separate elements existed in the prior art does not establish obviousness of a patented invention absent the teaching or suggestion in the prior art to combine these elements." *Arkie Lures, Inc. v B.G. Larew Tackle, Inc.* 43 USPQ2d 1294 (Fed. Cir. 1997). It is also clear that the Examiner is using hindsight to recreate the claimed invention by stating: "Sugawara's lack of an explicit teaching for suitable stain blockers motivates one to look to the prior art to find such." One skilled in the art would not pick and choose from five different references the elements of the claimed invention without suggestions to do so. It is easy for the examiner to look for the pieces in the prior art having seen the present claimed invention. The suggestion to look for the prior art is not evidence of motivation.

In view of the above, it is respectfully submitted that the Examiner's rejection is inappropriate and should be withdrawn.

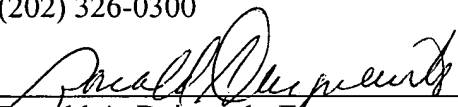
In view of the above, it is respectfully submitted that the Examiner's rejections of the claims should be withdrawn and all of the present claims passed to allowance.

If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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